8-12-05 TRW 3627

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August 8, 2005

Director of Technology Center 3600
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3627
Patent Examiner Steven McAllister

Re:	**Application No.:**	**09/849,625**
	Applicants:	**McGrady, et al.**
	Confirmation No.:	**9504**
	Title:	**Method of Tracking and Dispensing Medical Items**
	Docket No.:	**D-1137**

Sir:

Please find enclosed Applicants' Petition For Withdrawal of Election Requirement for filing in the above referenced application. Pursuant to 37 C.F.R. § 1.181, no fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Petition and any other fee due to Deposit Account 10-0637.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Director of Technology Center 3600, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 10th day of August 2005.

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D-1137

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of **McGrady, et al.**	)	
Application No.: **09/849,625**	)	Art Unit 3627
Confirmation No.: **9504**	)	
Filed: **May 4, 2001**	)	Patent Examiner Steven McAllister
Title: **Method of Tracking and Dispensing Medical Items**	)	

Director of Technology Center 3600
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated June 28, 2005, kindly enter Applicants' Petition in the above identified Application without prejudice as follows:

PETITION FOR WITHDRAWAL OF ELECTION REQUIREMENT

Applicants respectfully petition for withdrawal of the species election requirement presented in the Office Action dated March 25, 2005. Reconsideration of the election requirement was requested in a Response filed April 14, 2005. As best understood, the election requirement was made final in the Office Action dated June 28, 2005.

Applicants respectfully submit that the species election requirement should be withdrawn as it is legally improper. Applicants respectfully submit that the election requirement is not valid, nor is the asserted basis for the requirement a valid basis for requiring election. Applicants respectfully request that the election requirement be withdrawn and that all of the claims 1-25 be examined. Applicants' Response filed April 14, 2005, which includes valid reasons why the election requirement is improper and should be withdrawn, is *incorporated herein by reference.*

Applicants' Reply to comments in the Office Action ("Action") dated June 28, 2005

The Serious Burden and Timeliness Issue

MPEP § 803 sets forth criteria for a proper election requirement. One of the criteria is that there must be a serious burden on the examiner in order for election to be required. Conversely, if the search and examination of an entire application can be made without serious burden on an examiner, then it must be examined on the merits (which examination has already occurred). As discussed in more detail hereinafter, as the application has already received a complete action on the merits, the criteria for establishing serious burden has not been met. Another criteria for a proper election requirement is that it be in compliance with 37 C.F.R. §

1.146 which requires that a "species" restriction requirement be made in the first action on an application. As discussed in more detail hereinafter, the requirement was not in the *first* action taken in the application. It follows that this criteria for a proper election requirement has also not been met.

The fact that an examination on the merits has already occurred is *prima facie* evidence that there is no serious burden. Appellants respectfully submit that the requirement is not legally proper because the criteria for serious burden has not been met. Rather, the lengthy prosecution history is evidence in direct conflict with the sudden allegation of serious burden. The application has *already* been searched, there has *already* been an examination, and the examination was part of a complete action on the merits. Furthermore, generic claims (and each of the alleged species) were already fully examined. How can the current Examiner allege that the burden to examine the application is too hard when another Examiner has already easily performed a complete action on the merits?

Contrary to the current Examiner's opinion, (by inference) the prior Examiner assigned to the application concluded that there was no need for an election requirement. Hopefully, the Actions of this prior Examiner were "complete as to all matters" in accordance with 37 C.F.R. 1.104(b). Further, the standards of examination "must be the same throughout the Office" (MPEP § 706(I)). Thus, the prior Examiner's conclusion of no need for election requirement constitutes prosecution history estoppel. Otherwise, the Office is admitting on the record that all of the previous Office Actions by the prior Examiner did not meet the examination standard of the Office. Is the Office admitting that it did not previously conduct a proper handling of the application (which necessitated needless Response by Applicants thereto)? Also, all of the

Office Actions have come from the same Art Unit. Is the Office admitting that the examination standard of that Art Unit freely changes?

The Office has no legal basis for election requirement just because an application was reassigned to another Examiner, especially in the same Art Unit, as is the current situation. Again, this would violate the Office's requirement for applying a same standard of examination. Applicants request that the application be returned to the previous Examiner (who disagrees with the current Examiner's assessment of serious burden).

The Examiner's reference to "due diligence" (at Action page 2) is without merit. With the Examiner's reasoning, in order to be completely diligent he would also reexamine the applied patents, and if determining that they were never patentable, then vacate the current rejections and allow the application. As the Examiner is not permitted to comment on the validity of issued patents, he is also not permitted to use reassignment of an already examined application as an excuse to treat the application "as if the case had never been acted upon" (Action page 2). The fact remains, the application was already "acted upon," including a complete action on the merits.

As the prosecution history shows, this application has received numerous Office Actions. An Art Unit is not authorized to use application reassignment as an excuse to circumvent the rules and Office procedures. Unless the Office has a newly stated policy of causing needless time and expense by Applicants to respond to a complete action on the merits before first applying an election requirement, then the requirement by the Examiner must be deemed arbitrary and capricious.

The Mutually Exclusive Issue

The "mutually exclusive characteristics" (MPEP § 806.04(f)) and the "relationship" (MPEP § 808.01(a)) of the alleged species have not been provided to Applicants. As discussed in more detail in Applicants' Response filed April 14, 2005, any valid reason why the alleged species are distinct species remains absent.

In accordance with MPEP § 806.04(f), "Claims to be restricted to different species must be mutually exclusive." However, the Examiner has not demonstrated one example of the alleged species being mutually exclusive. The Examiner has not fully responded to Applicants' arguments set forth in the Response filed April 14, 2005. Instead, the Examiner merely states that "Regarding Applicant's argument that the Species Requirement must show that the species are mutually exclusive, the examiner respectfully disagrees" (Action page 2). It follows that the Examiner's disagreement is with the explicit requirement set forth in MPEP § 806.04(f). That the election requirement is not in compliance with the MPEP is further evidence that the requirement is improper.

The Grouping of Species Issue

The prosecution history shows that the Examiner has already issued three separate and distinct election requirements (i.e., in the Office Actions dated 09/07/04, 12/08/04, and 03/25/05). The Examiner admits (at Action page 2) that claim 25 was previously indicated as generic. However, the Examiner now regards claim 25 as no longer being generic (i.e., a fourth election requirement). Applicants respectfully request the Office to inform them when the Examiner will be finished making attempts at election requirement.

Conclusion

For all the foregoing reasons it is respectfully submitted that there is no valid basis for the species election requirement. Applicants respectfully request that their Petition be granted and the requirement withdrawn. If further request for reconsideration is first required, then this Petition should be considered as such.

Respectfully submitted,

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